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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,478	02/12/2004	Nicola Funnell	1578.607 (11758-US-PAT)	2295
44298	7590	03/12/2010	EXAMINER	
DOCKET CLERK Kelly-Krause PO BOX 12608 DALLAS, TX 75225			MANOJARAN, MUTHUSWAMY GANAPATHY	
			ART UNIT	PAPER NUMBER
			2617	
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			03/12/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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portfolioprossecution@rim.com

**Office Action Summary****Application No.**

10/777,478

**Applicant(s)**

FUNNELL, NICOLA

**Examiner**MUTHUSWAMY G.  
MANOHARAN**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 1/4/2010 have been fully considered but they are not persuasive.

Applicant argues that, Tohono not only fails to disclose or suggest the recited predefined order but further fails to disclose or suggest the responding to a determination that the same IE type is not included in each SIB by acting upon the system information associated with the SIB IEs while refraining from using the predefined order.

Examiner respectfully disagrees. The primary reference, 3GPP teaches that System information block of type 11 and 12. Tohona is applying the system information associated with the active cell (reads on SIB 11) first before applying the system information associated with the handover destination candidate cell this automatically satisfies the predefined order where the predefined order being to act on system information associated with an IE in a SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12). This automatically satisfies the condition.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 7-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1, 7 and 8 , the claim contains the subject matter," responding to a determination that the same IE type is not included in each SIB by acting upon the system information associated with SIB IEs while refraining from using the predefined order" was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The dependent claims 2-3 and 9-10 are also rejected, since they depend on rejected independent claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over 3GPP (TS 25.331 v3.16.0 (2003-9)) (hereinafter Reference (A)) in view of Tohono (US 2003/0040312).**

Regarding **claim 1**, Reference (A) teaches a method for handling system information in a user equipment device configurable for use in a mobile telecommunications system, method comprising:

receiving a system information block of type 11 (SIB 11) relating to measurement information ("system Information Block type 12 (SIB 12)" in Section 8.1.1.6.11) which relates idle and connected mode (line 2 ,14, and 22 in Section 8.1.1.6.11) and receiving a system information block (SIB) relating to measurement information of type 12 (SIB 12) ("system Information Block type 12 (SIB 12)" in Section 8.1.1.6.12) which relates connected mode (line 1 in Section 8.1.1.6.12), each of the system information blocks of type 11 (SIB 11) and 12 including at least one system information block information element (SIB IE) (lines 29-31 in Section 8.1.1.6.11) the information element related to a cell information list (lines 7-9, lines 24-28 and lines 31-32 in Section 8.1.1.6.11; lines 14-53 in Section 8.1.1.6.12) and having associated system information ("measurement identity", line 20 in Section 8.1.1.6.11 );

determining if a same information element is included in each of the SIB 11 and the SIB 12 (lines 49-50 in Section 8.1.1.6.11 and section 8.1.1.6.12).

Reference (A) did not teach specifically providing a predefined order for applying system information associated with system information block (SIB) information elements (IEs), the predefined order being to act on system information associated with an IE in a

SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12); responding to a determination that the same IE type is not included in each SIB by acting upon the system information associated with SIB IEs while refraining from using the predefined order; and responding to a determination that the same IE type is included by acting upon the system information associated with the identified same IE types according to the predefined order.

However, Tohono teaches in an analogous art method of providing a predefined order for applying system information associated with system information block (SIB) information elements (IEs), the predefined order being to act on system information associated with an IE in a SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12); responding to a determination that the same IE type is not included in each SIB by acting upon the system information associated with SIB IEs while refraining from using the predefined order; and responding to a determination that the same IE type is included by acting upon the system information associated with the identified same IE types according to the predefined order

(active cell is searched first and then hand-over destination candidate cell, Paragraphs [0056-0059]; Note: It is well known in the art that cell information list corresponding to the active cell reads on SIB 11 and cell information list corresponds to handover destination candidate cell reads on SIB 12 from Tohona,

Since Tohona is applying the system information associated with the active cell (reads on SIB 11) first before applying the system information associated with the

handover destination candidate cell this automatically satisfies the predefined order where the predefined order being to act on system information associated with an IE in a SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12)).

Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to use the method of providing a predefined order for applying system information associated with system information block (SIB) information elements (IEs), the predefined order being to act on system information associated with an IE in a SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12); responding to a determination that the same IE type is not included in each SIB by acting upon the system information associated with SIB IEs while refraining from using the predefined order; and responding to a determination that the same IE type is included by acting upon the system information associated with the identified same IE types according to the predefined order in order to provide an efficient search strategy.

Regarding **claim 2**, Reference (A) teaches a method according to claim 1, wherein the system information block information element is selected from the following system information block information elements; an information element relating to an intra-frequency cell information list (Section 10.3.7.33), an information element relating to an inter-frequency cell information list (Section 10.3.7.13) and an information element relating to an inter-Radio Access network (RAT) cell information list (Section 10.3.7.23).

Regarding **claim 3**, Reference (A) teaches a method according to claim 1 wherein the system information block information element is any of the following: "intra-frequency cell info list", "inter-frequency cell info list" and "Inter-RAT cell info list" (lines 28-30 in Section 8.1.1.6.11 and lines 8-10 in section 8.1.1.6.12).

Regarding **claim 7**, Reference (A) teaches a method for handling system information in a user equipment device, the device enable for use in a UMTS mobile telecommunications system, the system comprising a network of a plurality of cells:

receiving at least one each of system information of type System information Block (SIB) 11 and system information of type SIB 12; each of the SIB 11 and SIB 12 includes a same one or more information elements (IEs) relating to any of "intra-frequency cell info list", "inter-frequency cell info list" and "Inter-frequency cell info list" (lines 28-30 in Section 8.1.1.6.11 and lines 8-10 in section 8.1.1.6.12; Section 8.1.1.4, lines 1-3; Section 8.5.23, lines 6-15).

Reference (A) did not teach specifically a method of providing a predefined order for applying system information associated with system information block (SIB) information elements (IEs), the predefined order being to act on system information associated with an IE in a SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12); responding to a determination that the same IE type is not included in each SIB 11 and SIB 12 by acting upon the system information associated with SIB IEs while refraining from using the predefined order; and responding to a determination that each of the SIB 11 and SIB 12 includes the same IEs by acting upon the system information associated with the



SIB IE in SIB 11 and then applying the system information associated with corresponding SIB IE in SIB 12, according to the predefined order .

However, Tohono teaches in an analogous art a method of providing a predefined order for applying system information associated with system information block (SIB) information elements (IEs), the predefined order being to act on system information associated with an IE in a SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12); responding to a determination that the same IE type is not included in each SIB 11 and SIB 12 by acting upon the system information associated with SIB IEs while refraining from using the predefined order; and responding to a determination that each of the SIB 11 and SIB 12 includes the same IEs by acting upon the system information associated with the SIB IE in SIB 11 and then applying the system information associated with corresponding SIB IE in SIB 12, according to the predefined order .

(active cell is searched first and then hand-over destination candidate cell, Paragraphs [0056-0059]; Note: It is well known in the art that cell information list corresponding to the active cell reads on SIB 11 and cell information list corresponds to handover destination candidate cell reads on SIB 12 from Tohona, Since Tohona is applying the system information associated with the active cell (reads on SIB 11) first before applying the system information associated with the handover destination candidate cell this automatically satisfies requirements of the condition).

Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to use a method of providing a predefined order for applying system

information associated with system information block (SIB) information elements (IEs), the predefined order being to act on system information associated with an IE in a SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12); responding to a determination that the same IE type is not included in each SIB 11 and SIB 12 by acting upon the system information associated with SIB IEs while refraining from using the predefined order; and responding to a determination that each of the SIB 11 and SIB 12 includes the same IEs by acting upon the system information associated with the SIB IE in SIB 11 and then applying the system information associated with corresponding SIB IE in SIB 12, according to the predefined order in order to provide an efficient search strategy.

**Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reference (A) in view of in view of Tohono (US 2003/0040312) and Laitinen et al. (hereinafter Laitinen) (US 6765891).**

Regarding **claim 8**, Reference (A) teaches receiving two system information blocks (SIBs), each SIB comprising at least one information element (IE) that is related to a cell information list and where each SIB is a different type of SIB; determine if a same IE is included in each of one SIB (a first SIB) and other SIB (a second SIB) relate to cell information list IE (lines 28-30 in Section 8.1.1.6.11 and lines 8-10 in section 8.1.1.6.12; Section 8.1.1.4, lines 1-3; Section 8.5.23, lines 6-15).

Reference A did not teach specifically a method of providing a predefined order for applying system information associated with system information block (SIB)

information elements (IEs), the predefined order being to act on system information associated with an IE in a SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12); responding to a determination that the same IE type is not included in each SIB 11 and SIB 12 by acting upon the system information associated with SIB IEs while refraining from using the predefined order; and responding to a determination that each of the SIB 11 and SIB 12 includes the same IEs by acting upon the system information associated with the SIB IE in SIB 11 and then applying the system information associated with corresponding SIB IE in SIB 12, according to the predefined order .

However, Tohono teaches in an analogous art a method of providing a predefined order for applying system information associated with system information block (SIB) information elements (IEs), the predefined order being to act on system information associated with an IE in a SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12); responding to a determination that the same IE type is not included in each SIB 11 and SIB 12 by acting upon the system information associated with SIB IEs while refraining from using the predefined order; and responding to a determination that each of the SIB 11 and SIB 12 includes the same IEs by acting upon the system information associated with the SIB IE in SIB 11 and then applying the system information associated with corresponding SIB IE in SIB 12, according to the predefined order .

(active cell is searched first and then hand-over destination candidate cell,  
Paragraphs [0056-0059]; Note: It is well known in the art that cell information list

corresponding to the active cell reads on SIB 11 and cell information list corresponds to handover destination candidate cell reads on SIB 12 from Tohona,

Tohona is applying the system information associated with the active cell (reads on SIB 11) first before applying the system information associated with the handover destination candidate cell this automatically satisfies the requirements of the claimed condition.

The combinations of Reference (A) and Tohono teaches all the particulars of the claim 1, except a microprocessor connected to memory, the memory comprising software disposed therein, the software configured to be run by the microprocessor, where the microprocessor running the software is configured to carry out at least the operations. However, Laitinen teaches in analogous art, a microprocessor connected to memory, the memory comprising software disposed therein, the software configured to be run by the microprocessor, where the microprocessor running the software is configured to carry out at least the operations (Col. 4, lines 29-40).. Therefore, it would be obvious to one of ordinary skill in the art at the time invention to implement the method using a a microprocessor connected to memory, the memory comprising software disposed therein, the software configured to be run by the microprocessor, where the microprocessor running the software is configured to carry out at least the operations. This modification provides a method of implementation of Radio Resource Control protocol for the UE-UTRAN radio interface.

Regarding **claim 9**, Reference (A) teaches the system information block information element is any of the following: "intra-frequency cell info list", "inter-

frequency cell info list" and "Inter-RAT cell info list" (lines 28-30 in Section 8.1.1.6.11 and lines 8-10 in section 8.1.1.6.12).

Regarding **claim 10**, Reference A further teaches two received SIBs comprise one type SIB 11 and one type SIB 12 (sections 8.1.1.6.11 and 8.1.1.6.12).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MUTHUSWAMY G. MANOHARAN** whose telephone number is (571)272-5515. The examiner can normally be reached on 7:00AM-2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eng George can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/  
Supervisory Patent Examiner, Art Unit 2617